

(d) REMARKS

The claims are 1, 4-6 and 8-12 with claim 1 the sole independent claim. Claim 1 has been amended to include the subject matter of Formulas I-IV in previously examined claim 3. Claim 7 has been cancelled since it is inconsistent with amended claim 1. New claims 10-12 have been added.

New claim 10 merely defines the Ti chelate of claim 1 to that of structural formula (I). This is not a new issue. New claim 11 employs the Ti chelate compounds (1) and (2) as supported by page 16, lines 21-23 and 27-28; page 17, lines 6-15 and page 74, lines 3-5. New claim 12 employs A1 hydroxycarboxylic compound and a monoazo iron compound as supported on page 40, lines 25-30 and page 45, lines 10-17. Claims 10-12 depend from independent claim 1. If claim 1 is deemed allowable, then these dependent claims are likewise, allowable. No new issues arise if claim 1 is found allowable, it is submitted.

Claims 3 and 7 were rejected as obvious over Arai '092, combined with Kishiki '171 and ACS or as obvious over Tanikawa '432, combined with Kishiki '171 and ACS. Claims 1, 3, 7 and 8 were rejected as obvious over Arai '092 or Tanikawa '432 in view of Kishiki and ACS. Claims 4, 5, 6 and 9 were deemed obvious over Arai or Tanikawa in view of Kishiki and ACS and further in view of either Tanikawa '065, Tamura '470 or JP '707.

Claims 1, 3, 4, 5 and 7 were also rejected as an obviousness-type double patenting over allowed claims 1, 3-6, 9 and 10 of Application No. 10/717,452 in view of Tamura or Tanikawa '432 and '065.

In the art rejection the Examiner admits that Arai does not disclose a magnetic toner of a polyester resin prepared by using a titanium chelate compound as a catalyst. To remedy that defect the Examiner relies on Kishiki for disclosure of a potassium titanyl oxalate catalyst as shown in Example 7, toner binder TB7, of Kishiki. That rejection is respectfully traversed.

To expedite prosecution, independent claim 1 has been amended to exclude the catalyst, potassium titanyl oxalate, said to meet instant Formula VII. Amended claim 1 recites Formulas (I-IV), but excludes Formula VII.

In WO/03/052521 (Kishiki), potassium titanyl oxalate is exemplified as a polyester-forming catalyst, together with dibutyltin oxide and tetrabutyl titanate. In present Comparative Example I, for instant Binder (5), tetramethyl titanate is employed as the catalyst. This compound is structurally similar to the tetrabutyl titanate of Kishiki. The results in present Table 4 on page 87 showed that the tetramethyl titanate provided a binder which, when used in a toner, showed unsatisfactory performance in the areas of image density, fogging and toner consumption.

Moreover, Arai merely discloses that the object for adjusting the value of the toner magnetization in the specific range is “to improve the image density and reading precision” and “to improve the dispersing property and durability of the magnetic powder with respect to the binder resin”(U.S. Patent 6,677,092, column 6, line 55 and column 8, line 8). Accordingly, Arai does not disclose or suggest the correlation between a specific range of the value of toner magnetization and its direct effect of reducing the toner consumption, which is a key unexpected effect of the present invention.

Furthermore, neither Arai nor Kishiki disclose or suggest that only by satisfying both of the specific range of the value of the magnetization recited in the instant claim 1 and by using a binder resin having a polyester component polymerized by using a specific Ti chelate compound as a catalyst, can the above beneficial reduced toner consumption effects can be achieved (see specification page 9, lines 19 to 23 and the Examples vs. Comparative Example 1 in Table 4). In Comparative Example 1, no titanium chelate was used, instead tetramethyl titanate was used.

Further, there is no motivation to combine Kishiki with Arai, since Arai is directed to improving a magnetic toner by employing specific magnetic powder, while Kishiki relates to improved offset resistance properties of a binder resin.

Regarding the Examiner's rejection of claims 3 and 7 under 35 U.S.C. §103(a) on the grounds set forth in paragraph 11 of the Official Action, it is noted that U.S. Patent 4,857,432 (Tanikawa '432) and U.S. Patent 6,379,855 (Hayashi) disclose a magnetic toner having a specific saturation magnetization and a specific remnant magnetization. The toner described in Table 2 of Tanikawa '432 meets certain magnetization limitations recited in the instant claims. Kishiki discloses a polyester toner binder resin obtained using a titanium compound as a catalyst which catalyst is different than that presently claimed.

However, neither Tanikawa '432 nor Hayashi disclose the object for adjusting the value of the magnetization in the specific range, nor do they suggest the relevance between the specific range of the value of the magnetization and the beneficial effect of reducing toner consumption, which is an important unexpected property of the present invention.

The Examiner has stated that claims 1, 3, 4, 5 and 7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-6, 9 and 10 of co-pending Application No. 10/717,452 (Application '452) in view of Tamura and Tanikawa '432, as evidenced by Hayashi.

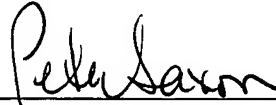
The claims of allowed Application No. 0/717,452 ('452 Application) recite the presence of a colorant, a release agent and an inorganic fine powder. Further, the allowed claims of the '452 Application require a polar resin containing at least 3 % by weight of a polyester unit formed in the presence of 0.01 to 2% of a titanium catalyst. In addition, the claims require a granulation step and a toner particle diameter of 4 to 10  $\mu\text{m}$ .

Present claim 1 recites none of these parameters. In addition, present claim 1 recites a magnetic toner with magnetic particles containing, inter alia, a magnetic ion oxide. Present claim 1 also recites  $\sigma_s$  and  $\sigma_r$  magnetization ranges. None of these magnetic toner features or magnetization ranges is present in the '452 Application claims. Clearly, the claims of the respective applications define distinct inventions. Certainly, the PTO could have restricted the present claims from the above-discussed allowed claims had they been presented in a single application. Further, there is no extension of the monopoly once the issued claims of the '452 Application expire, since one can clearly practice the claims of the '452 Application without infringing the instant magnetic toner claims. If the Examiner is unconvinced, then Applicants will consider expediting prosecution by filing a terminal disclaimer, once the prior art issues are resolved.

Accordingly, Applicants submit the Examiner has not raised a prima facie case of obviousness. The claims should be allowed and the case should be passed to issue.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Peter Saxon", written over a horizontal line.

Peter Saxon  
Attorney for Applicants  
Registration No. 24,947

FITZPATRICK, CELLA, HARPER & SCINTO  
30 Rockefeller Plaza  
New York, New York 10112-3801  
Facsimile: (212) 218-2200  
NY\_577679v1